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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,449	02/13/2001	Daisuke Tazuru	088941/0187	9561

22428 7590 09/09/2004

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/781,449

Applicant(s)

TAZURU, DAISUKE

Examiner

Marissa Thein

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on February 13, 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Priority*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Information Disclosure Statement*

The information disclosure statement (IDS) submitted on February 13, 2001 in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### *Drawings*

The drawings filed on February 13, 2001 are acceptable.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11 and 12 are rejected under 35 U.S.C. 101 because they fail to recite **computer executable** instructions. The claims are directed to machine-**readable** medium. Giving the term its broadest reasonable interpretation, the claims are directed to a program per-se and a program instruction. Accordingly, the claim fails to recite a positive functional interrelationship between the medium and the activities recited.

Please refer to MPEP 2106.

Claim 13 is rejected under 35 U.S.C. 101 because the recited steps does not apply, involve, use, or advance the technological arts since all the recited steps can be performed in the mind of the user or by use of pencil and paper. These steps only

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constitute an idea. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a business negotiation. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 13 is deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.**

**Patent No. 6141,653 to Conklin et al.**

Regarding claim 1, Conklin an apparatus for business negotiations, comprising:

- first registration device for creating estimate request information and registering the estimate request information on a homepage on the Internet (see at least col. 20, lines 23-34; col. 23, lines 42-58; col. 25, lines 41-59);
- a first transmission device for transmitting an estimate request occurrence notice to at least one predetermined prospective dealer via e-mail to inform that the

estimate request information is registered on the homepage (see at least col. 20, lines 23-34; col. 25, line 60 - col. 26, line 10);

- a first reception device for receiving from the prospective dealer via e-mail a response registration notice which shows estimate information decided by the prospective dealer based on the estimate request information registered on the homepage in response to the estimate request occurrence notice (see at least col. 20, lines 27-31; col. 23, lines 51-58; col. 24, lines 1-10; col. 25, line 60 – col. 26, line 18);
- a first reference device for referencing the estimate information on the homepage in response to the response registration notice (see at least col. 20, lines 27-31; col. 23, lines 51-58; col. 24, lines 1-10; col. 25, line 60 – col. 26, line 18);
- a decision device for selecting and deciding a dealer to be dealt with from the prospective dealers based on the estimate information referenced on the homepage and business conditions registered in advance (see at least col. 24, lines 22-41; col. 31, lines 12-25); and
- a second transmission device for transmitting a dealer decision notice via e-mail to the dealer (see at least col. 24, lines 22-41; col. 31, lines 12-25).

Regarding claims 2-8, Conklin discloses a reapplication device for registering new estimate request information by the first registration device and transmitting an estimate request occurrence notice to the predetermined prospective dealer again by the first transmission device when the business conditions registered in advance are not agreed on; a fourth transmission device for sending, to the prospective dealers other

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than the dealer decided on via e-mail termination notices which inform the prospective dealers that the estimate request has been terminated; a fifth transmission device for sending the estimate information to a person who is responsible for the estimate request information via e-mail after the dealer has been decided; the prospective dealers are sorted in accordance with the persons who are responsible for the estimate request information; wherein the business conditions include an acceptable price; a sixth transmission device for transmitting to an ordering manager, and acceptance request notice which confirms whether the price, which is listed in the estimate information and exceeds the acceptable price, can be accepted; decision device decides the dealer after the ordering manager has accepted the price listed in the estimate information. (See at least col. 14, lines 19-31; col. 24, lines 10-41; col. 24, line 66 – col. 25, line 20; col. 31, lines 12-25; col. 30, lines 1-51).

Regarding claim 9, Conklin discloses an apparatus for business negotiations comprising;

- a second reception device for receiving an estimate request occurrence notice from an ordering side via e-mail (see at least col. 14, lines 19-21; col. 25, lines 12-20; col. 21, lines 7-12; col. 25, line 42 – col. 26, line 19; Figures 15a-15c; Figures 16-19);
- a second reference device for referencing estimate request information on a homepage on the Internet in response to the estimate request occurrence notice (see at least col. 25, line 42 – col. 26, line 19; Figures 19-20);

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- a second registration device for creating estimate information based on the estimate request information, and registering the estimate information on the homepage (see at least col. 25, line 42 – col. 26, line 19; Figures 17-20);
- a third transmission device for transmitting a response registration notice to the ordering side via e-mail to inform that the estimate information is registered (see at least col. 25, line 42 – col. 26, line 19; Figures 17-22); and
- a third reception device to receiving a dealer decision notice based on the estimate information from the ordering side via e-mail in response to the response registration notice (col. 25, line 42 – col. 26, line 19; Figures 17-22).

Regarding claim 10, the claim is rejected on the same grounds as claims 1 and 9 above.

Regarding claim 11, the claim is rejected on the same grounds as claim 1 above.

Regarding claim 12, the claim is rejected on the same grounds as claim 9 above.

Regarding claim 13, Conklin discloses a method for business negotiations, comprising:

- registering estimate request information on a homepage on the Internet (see at least col. 20, lines 27-31; col. 23, lines 51-58; col. 24, lines 1-10; col. 25, line 60 – col. 26, line 18);
- registering prospective dealers (see at least col. col. 19, lines 14-37);
- transmitting to the prospective dealers via e-mail an estimate request occurrence notice which informs that the estimate request information is registered on the

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home page (see at least col. 20, lines 27-31; col. 23, lines 51-58; col. 24, lines 1-10; col. 25, line 60 – col. 26, line 18);

- receiving the estimate request occurrence notice and recognizing the estimate request occurrence (see at least col. 20, lines 27-31; col. 23, lines 51-58; col. 24, lines 1-10; col. 25, line 60 – col. 26, line 18); and
- acquiring the estimate request information from the homepage in response to the estimate request occurrence notice (see at least col. 20, lines 27-31; col. 23, lines 51-58; col. 24, lines 1-10; col. 25, line 60 – col. 26, line 18).

Regarding claim 14, Conklin discloses a step of creating estimate information based on the estimate request information and registering the estimate information on the homepage (see at least col. 20, lines 23-34; col. 23, lines 42-58; col. 25, lines 41-59).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,049,787 to Takahashi et al. discloses an electronic business transaction system for electronically effecting business transactions between companies and firms via communication network.

U.S. Patent No. 6,669,832 to Saito et al. discloses a request for a commodity that each office in an organization needs which is sent for a terminal in the office to a general affairs service center in the organization.



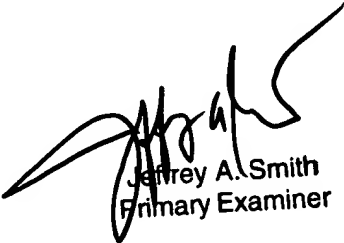
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
September 6, 2004



Jeffrey A. Smith  
Primary Examiner